

REMARKS

Reconsideration of the application as amended is respectfully requested. Claim 7 was previously deemed allowable. Claim 1 is amended herein, and claims 1-8 are in this application. It is submitted that these claims are patentably distinct over the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. § 112. Changes to these claims are presented not for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112, but simply for clarification and to round out the scope of protection to which Applicants are entitled.

Initially, Applicants duly note the double patenting rejection. At paragraph 1 of the present Office Action dated September 24, 2003, claims 1-8 are rejected under 35 U.S.C. 112, second paragraph for improper antecedent basis with regard to the term “directly.” The Examiner in the Action suggests a way to resolve this which is acceptable to Applicants, and thus claim 1 has been amended herein to overcome the 112 rejection to claims 1-8.

Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over what the Examiner asserts is “applicant’s Jepson claim” in view of Eklund.

Appellant respectfully traverses this position for the following reasons.

Amended claim 1, which is not in Jepson format, now recites in part, “a transfer belt having...a web-contacting surface which has a pressure-sensitive resettable degree of roughness” that provides an improved transfer of a soft tissue web from a shoe press nip directly to a Yankee cylinder. Accordingly this feature is neither disclosed nor suggested in an alleged “applicants’ Jepson claim.”

Nor is this feature disclosed or suggested by Eklund. Eklund shows a belt whose surface has a pressure-responsive recoverable degree of roughness, that is, the belt has a smooth surface when compressed in a press nip, but a relatively rough surface when not in a press nip. This is a feature that enables a paper web to be removed from the transfer belt downstream from a press nip by a vacuum transfer roll.

The belt of the present invention, on the other hand, transfers a tissue web to a Yankee drying cylinder at a nip. However, Eklund teaches that the surface of the transfer belt becomes smooth in a nip, and that, as a consequence, a paper or tissue web would not be readily removable at such a point.

More specifically, the Eklund belt is shown to carry a paper web through press nips. However, without exception, the paper web is carried from the nip on the surface of the belt because the belt is smoother (in the nip) than the press fabric used to dewater it. Subsequent transfer from the surface of the transfer belt is always shown to be accomplished using a vacuum-transfer roll, not a nip, such as that formed by two rolls. Consequently the Eklund reference does not teach or suggest that a paper web could be transferred from the transfer belt in a press nip.

As noted above, compressing the Eklund belt makes its surface smooth and allows a thin water film to form between the belt and the paper sheet. This film provides adhesion between the belt and the sheet so that the sheet follows the belt as it leaves the nip. In this connection, the belt expands in the direction of thickness and approaches its non-compressed state such that the water film breaks up.

Moreover, Eklund clearly teaches that the belt is smoothest under compression, that is, in a press nip. Eklund also teaches that the smoothness under compression is what allows the water film which keeps the sheet firmly in contact with the belt surface to form in the first place. Sheet release occurs outside a press nip because of increasing surface roughness as the belt expands, and because the hydrophilic/hydrophobic areas allow water beads to form from the water film between the paper web and the surface of the belt. Both of these effects allow the sheet to be released from the surface of the belt outside of a nip.

Accordingly, the present invention as claimed in amended claim 1, is neither shown nor suggested by Eklund because Eklund teach away from this. That is, since Eklund's belt transfers a paper web from the press section to a dryer fabric, it would be surprising that Eklund's belt is advantageous in transferring a web from a shoe press nip directly to a Yankee cylinder. In a Yankee cylinder, the conditions are, in fact and as is known, quite different from those in a press nip. In a Yankee cylinder, there is no pressing of the soft tissue web for direct dewatering but it is instead a matter of supporting the soft tissue web against the outer surface of the Yankee cylinder, such that the fibers of the soft tissue web adhere to the surface of the cylinder. Yet precisely this effect is achieved by Appellants' claimed transfer belt. Consequently, Eklund would not motivate one of ordinary skill in the art to include an Eklund belt, because Eklund teaches away from this.

For the reasons discussed above, claim 1 is respectfully submitted to be patentable over the cited reference, as are claims 2-6 and 8 which depend therefrom.

In further support of the above arguments, it is well established that there must be some prior art teaching which would have provided the necessary incentive or motivation for modification. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Indeed, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.”

In particular, for a Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not in Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). In the present situation, both the suggestion of the claimed invention and the expectation of success are not found in Eklund, and thus, this reference fail to provide the necessary incentive or motivation that would lead a skilled artisan to practice the present invention. That is, Eklund does not disclose or suggest a transfer belt which carries a tissue web to a Yankee drying cylinder and transfers the tissue web to the cylinder at a nip, wherein the transfer belt's web-contacting surface has a pressure-sensitive resettable degree of roughness.

It is respectfully submitted that the present application is in condition for allowance. An early notice to this effect is earnestly solicited.

Respectfully submitted,

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